

In the parent application, the claims were rejected under 35 U.S.C. 102(e) over the patent to Pirig.

Claim 1 of the application defines a method of painting a surface in predetermined color by providing a paint including a film-forming binder component for forming a film of the paint on the surface, a color-producing component for providing the predetermined color on the surface, and a fire-retardant component adapted to protect the surface from consequences of fire; and painting the surface with said paint so as to impart the predetermined color to the surface and also to protect the surface from fire.

In contrast, the reference discloses a flame-retardant coating which forms an insulating layer and is based on substances which carbonize and form a foam layer in the event of a fire. The invention disclosed in the reference deals exclusively with application of a flame-retardant coating on a corresponding surface and it has nothing to do with the method of painting a surface and predetermined color in accordance with the present invention. In the reference the surface is not painted with a paint, but instead is covered with a coating. In the reference the surface is not painted with a paint to

impart a predetermined color to the surface, but instead the surface is covered to protect it from fire exclusively.

Applicants enclosed herewith a Declaration of Unobviousness made by an expert in this field, which shows that a person skilled in the art finds these two solutions to be completely different and incomparable with one another. It is believed that a method of painting a surface in a predetermined color as defined in claim 1 of the present application clearly and patentably distinguishes the present invention from the prior art represented by the patent to Pirag.

Claim 9 defines a paint for painting a surface in a predetermined color, which includes film-forming binder component for forming a film of the paint on the surface; a color-producing component for providing the predetermined color on the surface; and a fire-retardant component adapted to protect the surface from consequences of fire, such that when a surface is painted with the paint, the predetermined color is imparted to the surface and the surface is protected from fire, while claim 24 defines a method for producing a paint for painting a surface in a predetermined color which includes the steps of mixing a film-forming binder component for forming a film of the paint on the surface, and a color-

producing component for providing the predetermined color on the surface; and adding a fire-retardant component adapted to protect the surface from consequences of fire, so that when a surface is painted with the thusly produced paint, the predetermined color is imparted to the surface and the surface is protected from fire. The patent to Pirig has also nothing to do with paints for painting a surface in a predetermined color and has nothing to do with a method for producing paints for painting a surface in a predetermined color. In the opinion of the above-mentioned expert the paint disclosed in the patent application as well as the method for producing the paint are completely different from the coating and the method of producing the coating disclosed in the patent to Pirig. A person skilled in the art of paints, would not fslook for solutions for new paint for painting a surface in a predetermined color and for a new method of producing of the paints, in the area of fire-retardant coatings. Thus, claims 9 and 24 clearly and patentably distinguish this invention from the prior art.

Claim 5 defines that in a method of painting in accordance with the present invention, the painting is performed with a paint which includes in addition to a color-producing component, also a fire-retardant component which does not include 15 weight % of the paint. Claim 13 deals with a paint which includes this feature, and claim 28 defines a method of making a paint

which includes this feature. The features of these three claims clearly and patentably distinguish the present invention from the prior art represented by the patent to Pirig. In the patent to Pirig the coating disclosed in the reference includes a fire retardant part of the patent composed of Exolit, melamine polyphosphate and dipentaerythritol in all examples, which jointly form 53 weight % in Example 2, 61 weight % in Example 4, and 58 weight % in Example 6.

This represents a tremendous difference between the coating in the patent to Pirag and the paint of the present invention. If for some unknown and highly improbable reasons a person skilled in the art used such a fire retardant part in a paint of the present invention or in any other paint, the paint would be completely compromised and it would no longer perform its functions as a paint for coloring of surfaces. The total composition of the paint would be completely distorted and the paint will no longer maintain its properties and will be no longer usable for painting surfaces in predetermined colors. Thus, it is believed to be clear that these claims also clearly and patentably distinguish the present invention from the prior art.

Claims 8, 16, and 31 define that the paint has a filler, in the method of painting the paint with the filler is utilized and in the method of

producing the paint a filler is introduced into the paint. The provision of the filler clearly indicates that the product of the present invention is a paint and not a coating similar to the coating disclosed in the patent to Pirig. The patent to Pirig does not disclose any examples in which a filler is provided. It is therefore believed that these claims also clearly and patentably distinguish the present invention from the prior art represented by the patent to Pirig.

As was stated in the decision *Atlas Powder Co. v. Ireco Inc.*, 51

USPQ 2d 1943, 1945-46:

"To anticipate a claim a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. Anticipation of a patent claim requires a finding that the claimed issue "reads on" a prior art reference".

The reference does not disclose either explicitly or inherently a method of painting, et al, and it does not disclose either explicitly or inherently a paint and a method of producing a paint in accordance with the present invention.

Also, it is respectfully submitted that the reference clearly belongs to a non-analogous art, and therefore a person skilled in the art

would never consider the teaching of the reference to develop a method of painting, a paint and a method of producing a paint in accordance with the present invention.

As stated in the decision *Scripps Clinic and Research Found v. Genetech, Inc.*, 18 USPQ 2d 1001, 1010:

In validity for anticipation requires that all of the elements and limitations of the claims are found within a single prior art reference. There must be no difference between the claimed invention and the reference disclosure as viewed by a person of ordinary skill in the field of the invention."

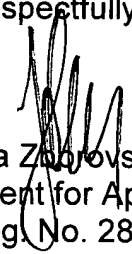
Definitely, in light of this decision, the above-mentioned claims should also be considered as patentably distinguishing over the art and should be allowed.

As for the other dependent claims, they depend on the corresponding independent claims and they should be allowed.

Consideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,



Ilya Zaporovsky  
Agent for Applicant  
Reg. No. 28563